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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE PETITIONS OFFICE

Patent Number: 6,505,391 B1

Patent Date: 2003 Jan 14

Applicant: Philippe Berna

Patent Title: PROCESS FOR MAKING A VERSATILE CLAMPING DEVICE  
DESIGNED TO HOLD OBJECTS WITHOUT DAMAGING THEM, SUCH A  
DEVICE AND ITS USE.

This patent has been issued on application No. 08/580,493, filed on 1995 Dec 29, which is a continuation of application No. 08/321,589, filed on 1994 Oct 12, now abandoned, which is a continuation of Serial No. 07/938,211, filed on 1992 Sep 3, now abandoned, and itself the National Stage of International Application No. PCT/FR91/00190, filed on March 8, 1991.

Examiner/GAU: David Bryant/3726

Molières-sur-Cèze, France, 2003, July 13, Sun

PETITION FOR SUSPENSION OF THE RULES WHICH WOULD  
CONFER RETROACTIVITY (PRIOR TO JUNE 8, 1995) AND  
DISCRIMINATIVE FORCE TO URAA BY OVER-INTERPRETATION.

THIS PETITION IS FILED UNDER RULE 183 AND FEE SET FORTH IN  
RULE 17(h) IS PAID BY CREDIT CARD.

Hon. Commissioner for Patents  
Washington, District of Columbia 20231

Sir:

In absence of any response to 2 clarification requests from the PTO and according to some recent phone calls, it seems that an over-interpretation of 35 U.S.C. 154-(a) (2) by some PTO employees would grant to patent 6,505,391 a term of 20 years from March 8, 1991. Accordingly this patent would expire on March 8, 2011.

1. That would give to this patent, which was issued on January 14, 2003, a term of only 8 years from grant. That appeared after deep investigation from the receipt date of the patent deed and somewhat also from the receipt date of the notice of allowance. At the time patent 6,505,391 was applied for on March 8, 1991, through the PCT, the U.S. Patent law was 17 years for the patent term from the issuance whatever the number of continuous applications the Examiners could require. And this law was also allowing for the time the PTO would take, with slips or not, to

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handle mail for all these applications and for the delays the Postal Service could cause. Now, current text of 35 U.S.C. 154-(a) (2) has been adopted in Public Law 103-465 (URAA) under Sec. 532. (patent term and internal priority) only on December 8, 1994 and made effective on June 8, 1995. In compliance with the U.S. Constitution (see article I, section 9, § 3, and section 10, § 1), this law cannot have an effect prior to this last date (no ex post facto Law). In other words, a 20 years patent term should only start from an earlier application filing date, which could be only after June 7, 1995. That means that patent 6,505,391 should expire at the earliest, provided of course that all maintenance fees would be paid on due time and there would be no terminal disclaimer, on Dec. 29, 2015. If interpretation of URAA would make patent 6,505,391 expiring on March 8, 2011, because this patent originated from a filing on March 8, 1991, that would be as if the URAA was in force by March 8, 1991 and contradicted the U.S. Patent law of this time. In other words, Public Law 103-465 (URAA) would also act for the past. If by a particular interpretation, URAA could give a continuous application the capacity of changing the way of calculating the term for a patent applied for in the past of June 8, 1995, it would confer to itself a retroactive force.

2. On the other hand, there is no mention in Public Law 103-465 that a continuation application could change the term of a patent issued from an original application filed before June 8, 1995. Besides, by providing that patent term starts from the earliest date of filing under 35 U.S.C. 120, 121 or 365 (c), this law exactly stipulates that a continuation application cannot change the expiration date of a patent issued from an original application filed on or after June 8, 1995. Whatever is the number of continuation applications filed for getting such a patent, the 20 year-term would always start from the same earliest filing date. There is only one purpose in the URAA regarding the patent term. In accordance with the TRIPS of the GATT which require no more, this purpose is to have any patent originated in an original application having a filing date, which is after the date the GATT was adhered to, expiring 20 years from this filing date, whatever are the intermediate steps. There is not a second purpose, for example that an intermediate step such as a continuation application could change the way of calculating the term of some patents based upon an original filing date anterior to June 8, 1995. Besides, the TRIPS of the GATT are purely ignorant of what a continuous application is. Such an intermediate step is purely American. There would be discrimination if a continuation application could change the term of a patent or not, depending on its original filing date. Regarding the patent term, an applicant who has originally filed by June 7, 1995 does not get what she/he was expecting; another applicant who originally filed after this date gets what she/he was expecting. Various statutes are banning discrimination in the United States. Notably, International Covenant on Civil and Political Rights, to which the United States adhered to on June 8,

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1992, prohibits any kind of discrimination in its article 26:

“All persons are equal before the law and are entitled without any discrimination to the equal protection of the law. In this respect, the law shall prohibit any discrimination and guarantee to all persons equal and effective protection against discrimination on any ground such as race, color, sex, language, religion, political or other opinion, national or social origin, property, birth or other status.”

Accordingly patent 6,505,391 should be given only a term of 17 years from issuance date, because it derives from an original filing date, which is before June 8, 1995. So patent 6,505,391 should expire in fact on Jan. 14, 2020, provided of course that all maintenance fees would be paid on due time and there would be no terminal disclaimer.

The 2 clarification requests were respectively filed on February 13, 2003 and on March 26, 2003.

3. From another standpoint, the proceedings, which led to this patent, suffered from two sources of undue delays:

(A) Examination was first in charge of a Primary Examiner, S. Thomas Hughes, whose behavior caused waste of time. S. Thomas Hughes was the Primary Examiner of this case for more than 6 years (from 11/06/1992 to beyond 12/30/1998). At the end of this period during which he delivered around ten (non-final, final and advisory) actions, only a few secondary claims were found containing allowable matter. David Bryant succeeded to him as Primary Examiner of this case for a first action on 07/28/1999. Less than 3 years (including a sabbatical year of David Bryant during which S. Thomas Hughes replaced him for two non-advancing actions –non-final and final) later, a notice of allowance was issued (on 06/17/2002) for all the claims S. Thomas Hughes persisted before to reject. And there has been meanwhile no need to narrow these claims in scope, on the contrary. From the analysis of S. Thomas Hughes' first two actions, it appeared clearly to applicant that with this Primary Examiner the procedure was in danger of lasting eternally and as soon as on 07/29/1994, he alerted the Commissioner in a complaint. S. Thomas Hughes was showing a poor technical level and a very marked carelessness in his negative assertions. This complaint was unfortunately denied. But as S. Thomas Hughes continued to manifest the same behavior, applicant filed two more complaints against him, one on 01/22/1996 and a third one on 01/02/1997. These complaints were also denied as petitions, despite S. Thomas Hughes, beyond his two first actions, persisted to (please, refer to papers 7, 16, 21, 23, 27, 28, 36, 43, and 46):

(i) show a poor technical level, evidencing ignorance of what cylindrical does mean (see for example paper 7, pages 2-3, paper 16, page 2 and paper 21, page 3), and unfamiliarity with mechanics and clamps, by

(1) opposing only prior inventions having only a weak relation to the

examined invention (see for example the "hip clamp" of Neff), alone or in combination. It was apparent that S. Thomas Hughes could hardly perceive the difference between a clamp with a means to exert a clamping force, such as a strong spring or a screw, and a clamp without such a means. He persisted to mainly oppose an aggregation of two irrelevant clamps (Neff's hip clamp and Thornton's big clothespin) equipped each with such a means to the clamp according to the examined invention, which has not such a means.

- (2) granting imaginary virtues to these prior inventions (in particular to Neff, Thornton, and Ditto, see paper 7, pages 5-6, paper 16, pages 4-6, paper 21, pages 5-6, paper 43, pages 6-7, paper 46, pages 4-6),
- (ii) require for even a small amendment a substitute specification (see for example paper 23, page 1), with complete disregard for the time and paper wasted,
- (iii) repetitively and casually contend that there are no antecedent basis for some terms used in some lines of claims, same terms being often defined (see for example paper 16, page 3, paper 21, pages 3 and 4) just in preceding lines,
- (iv) carelessly deliver assertions that new matter has been inserted in submitted substitute specifications or amended claims despite any previous such assertion had been shown unfounded (see for example paper 16, page 2, paper 27, page 2, paper 28, page 2)
- (v) contend that some claims have no support in the original specification (see paper 7, page 3, paper 36, section 5, paper 43, section 6) without consideration for the fact applicant showed him previously by citation of precise sections of text that such a contending was unjustified for other claims,
- (vi) manifest full insensitivity to any arguing from applicant of any advantage or photo showing a new and unexpected result of the invention versus prior art. Apropos of S. Thomas Hughes' insensitivity to this kind of arguing, it can be referred in particular to the 06/16/1995 applicant's affidavit where such an advantage with photos were put forward. Such affidavit was incomprehensibly dismissed "as not commensurate in scope with the claims" by S. Thomas Hughes on 07/26/1995 (see paper 23). More generally, S. Thomas Hughes showed insensitive to any adduced and evidenced advantage of the examined invention over the prior art, when an advantage brought over the past is nothing but a new and unexpected result. Such an advantage can be evidenced only if it is a result that has not until now been provided by this prior art. Accordingly, it is new. And if has not until now been provided by this prior art, that might be because it has not been yet imagined that it could exist or it has been thought unattainable or incompatible. So it is unexpected.

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From previous (iii) to (v) it may be supposed that S. Thomas Hughes contented himself to casually skim the submitted papers.

Fortunately, David Bryant adopted from the very beginning of his examination task a totally different behavior. He took the things seriously and did not waste time at asserting fancy things. He understood the invention practically at once and formulated suggestions for claims with competence. The result is that within less than two years (his sabbatical year, where S. Thomas Hughes replaced him for a quasi-dormancy period, should not be taken into account), a notice of allowance was issued for the sound set of claims the applicant was looking for. David Bryant's performance has been more than consistent with the requirement of the AIPA (Public Law 106-113) in its sec. 4402 (a) - 35 U.S.C. 154 (b) -. With his first action upon the case (on 07/28/1999, paper 56), David Bryant suggested an allowable rewording for independent claims 1-2 & 16. And with his second action upon the case (on 01/14/2000, paper 59), David Bryant suggested an allowable rewording for all dependent claims 3-15 & 17-18.

(B) Handling trouble:

- (i) On 12/15/1998 a continuing application was filed. On 12/30/1998, PTO initial examination of this continuing application resulted in an allegation that there was an imaginary 4<sup>th</sup> independent claim and accordingly the payment of an additional fee was required. After time consumed by postal delay and investigation, on 02/25/1999, this fee was paid and a petition was filed by Express Mail from France to get dismissal of this allegation. On failure of this express mail to reach the PTO by 02/28/1999, a fee for extension of time by one month was also paid on 03/29/1999. As there was no response from the PTO three months later, applicant filed a complaint on 07/04/1999 and on 07/14/1999, this allegation was dismissed. But thus, six and a half months were unduly wasted.
- (ii) On 11/06/1995, a petition and fee payment for a one-month extension was diligently mailed with priority but arrived only on 12/1/1995, that is to say 15 days after the date it should arrive to be timely. As a result, the continuing application filed on 12/29/1995 was improper. Because applicant was not informed of the late arrival of the 11/06/1995-priority mail, despite he called the PTO on phone several times meanwhile to inquire, there has been a great confusion. Both sides were confused, PTO, since PTO accepted payment and examination continued somewhat - see paragraph (iii) below - and applicant (who believed that everything was OK). This confusion lasted until the petition to revive the preceding application for unavoidable delay was granted that is to say on 10/06/1997. Would the applicant be informed, if only by fax (which is normally more affordable than a regular postal

service mail) that the payment of the fee for a month extension had been delivered too late, he would have filed by express mail a further month extension. And this confusion and corresponding waste of time would have been prevented. It is perhaps not the duty of the PTO of informing applicants of the late arrival of their mail. But it could have been expected that when an applicant calls on phone, the art unit in charge of his application, he could receive a precise information on the status of his application.

- (iii) An action, paper 36 from Primary Examiner S. Thomas Hughes mailed on 10/17/1996, was so formally vague and confusing that on applicant's request on 01/10/1997 (repeated on 04/02/1997), a new action - paper 43 - was necessitated from same Examiner (mailed on 12/15/1997). This delayed the advancement of the examination too.
- (iv) More likely for the sake of the PTO income, a notably large share of the mail from the PTO was sent through Philippines (Asia) to France (Europe) in 2001 and 2002. The minimum number of days of postal forwarding from the PTO to applicant's office went over 20 days from an average of ten days. On one occasion even, the mail arrived later than the date by which a response should be filed. A mail (paper 76) granting a one-month period for response was sent on 11/30/2001 and arrived only on 01/03/2002. That required a petition, which was granted on 03/14/2002. But some time again was wasted.
- (v) On 08/10/2001 was sent by FedEx, a continuing patent application to the PTO. But once the envelope taken away, FedEx for the first time required a street address and no more only a ZIP code. Applicant being confused by the street addresses given in the MPEP (sec. 501 and 502) called the number 1-800-PTO-9199 and was given by a customer service officer, a woman, a street address for a PTO tower, which was in fact occupied by Trademark employees. So FedEx delivered the envelope containing the continuing application at this address on 08/16/2001, which was the last day this application should be filed to receive the benefit of a two-month extension, petitioned and paid for in same envelope. Because of the time spent for conveying this envelope to the Patent employees in charge of patent applications, this application received first 08/23/2001 as filing date. After many unfruitful phone calls to the PTO, applicant was at last informed of the situation by Examiner David Bryant and filed a third-month extension petition with the payment of a \$250 fee. Subsequently on 11/16/2001, after pondering over, applicant filed a complaint, which was treated as a petition to get the filing date of the application changed to 08/16/2001 and accordingly to have the \$250 fee refunded. This petition was granted only on 05/28/2002 but in the meanwhile the examination was frozen and as a result more time was wasted. The notice of allowance followed this last date by

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just 20 days, on 06/17/2002.

4. If by a particular interpretation, the URAA could shorten the patent term from issuance to allow for the time lost because an Examiner like S. Thomas Hughes slowed down the examination, this would induce discrimination. This would induce discrimination between an applicant in the charge of a time-waster Examiner like S. Thomas Hughes and an applicant in the charge of a time-saver Examiner, like David Bryant. With this interpretation, if S. Thomas Hughes would have not been replaced as Primary Examiner, the patent might have been well delivered only after its term would have expired.

If by the same interpretation, the URAA could shorten the patent term from issuance to allow for the time lost because there was handling trouble, this would also induce discrimination. This would induce discrimination between an applicant suffering from handling trouble and an applicant suffering no handling trouble.

And as it was said in section 2 of this paper, various statutes are banning discrimination in the United States.

Should these delays have been avoided and they were avoidable, patent would have been issued earlier for a longer term and patentee could have devoted himself entirely to commercialization of the clamps according to the invention for a longer period. Instead of this, until now commercialization has remained almost confidential. Applicant, now patentee, has turned to be older (65) and time remaining for commercialization with exclusive rights would be according to this supposed over-interpretation of the URAA only for 8 years. If this over-interpretation would be maintained, patentee would be unfairly penalized three times. Firstly, he would have paid many more fees than it could be expected, notably in filing fees and time extension fees to the benefit of the PTO income. Secondly, he would have spent much more of his time and energy in proceedings than it could also be expected. Thirdly, the patent he would receive would be for only a much shorter term than provided for from the very start. That would appear as adversely unfair. Delays caused by misinterpretation by PTO initial examination team of continuing applications, by behavior of S. Thomas Hughes as Primary Examiner and by examination of all petitions granted are not the fault of the applicant.

Time extension fees were not a luxury because the response could not have been always filed within the 3-month statutory period. The mail from the PTO took an average of 15 days to reach applicant's office and time was required to mature the response, chiefly when facing the reckless actions from S. Thomas Hughes, to earn the money for paying the fees and to care about family and health.

If patent term is really only 8 years from issuance date, the only consolation is that there would be no need of paying the 3<sup>rd</sup> maintenance fee.

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5. There would have been a possibility of avoiding the effects of this over-interpretation: using the two submissions provided by rule 129(a). Applicant was advised in a final action (on July 3, 1995, sec. 13, paper 21) that he was entitled to have a first submission entered under this rule for a withdrawal of the finality upon a timely filing. But he was then not warned that if he would file a new continuation application instead, he would lose the benefit of 17 years term from issuance. Applicant did not see the advantage of filing a submission over filing a new continuation application. The fee was the same and continuation application filing was giving right to 2 actions: one non-final and one final. He was absolutely unaware of a possible danger of filing a continuation application after June 7, 1995 regarding the change of the patent term for an original application filed before. Until then, a continuation application was simply designed to provide the PTO with additional income. And there was no clear mention of such a danger in the MPEP issue of September 1995, that patentee kept. There was no chapter 2700 and 35 USC 154 (a) (2), as issued from a non ex post facto law, was apparently referring to new original applications filed after June 7, 1995 and rule 129(a) did not mention such a danger. And if at this time, a clear announcement of this danger had been made published on the Internet, it was inaccessible in France. The Internet has only been made available from 1998 in France (see Reuters, March 20, 1998) and this gradually. And applicant's attention was then chiefly preoccupied by the steadily negative position of S. Thomas Hughes on the ground. Anyway, only two submissions were allowed under 37 CFR 1.129(a). That proved to be insufficient. S. Thomas Hughes used two opportunities (one in his name and one in the name of David Bryant) and David Bryant one.

6. So patentee petitions the Commissioner with deference to suspend the rules, which could give Public Law 103-465 (URAA) a retroactive force and a discriminatory force and accordingly to make understandable on its front page, that patent 6,505,391 has a term of 17 years from grant.

7. The form for paying by credit card the \$130.00 petition fee is annexed hereafter.

Very respectfully submitted,

*Philippe BERNARD*

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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper of ten pages including this one and the following one for the credit card payment form PTO-2038, is being facsimile transmitted as a confirmation copy of the petition facsimile earlier today to the Patent and Trademark Office (petition office) on the date shown below.

Philippe Berna

*Philippe* BERNA

07 /14/03

Signature

Date